UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,661	07/05/2001	Winthrop A. Eastman	0483FV.044665	2676

7590 06/07/2004

BRYAN L. WHITE
Bracewell & Patterson, L.L.P.
PO Box 61389
Houston, TX 77208-1389

EXAMINER	
WEBB, JAMISUE A	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/899,661	EASTMAN, WINTHROP A.	
	Examiner	Art Unit	
	Jamisue A. Webb	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. With respect to Claim 1: the phrase "ascertaining from the order an appropriate number of appropriately sized containers" is indefinite. The claim recites previously that an order for "a shipping container" which is a singular term. Therefore it is unclear to the examiner if an order is placed for a single item, how it can be ascertained a number of containers, a plural term, when the order is for a single container.

4. Claim 1 recites the limitation "the container". There is insufficient antecedent basis for this limitation in the claim. Is this the container in the receiving step, or the containers in the ascertaining step?

5. With respect to Claim 1: the phrase "undertaking to deliver goods" is indefinite. It is unclear to the examiner what this phrase is actually referring to, and it is unclear what is actually being undertaken. Undertaking *what* to deliver?

6. With respect to Claim 1: the phrase "delivering the goods to" is indefinite. Wasn't the delivery of the goods already done in the undertaking step? Therefore it is unclear if the goods are delivered a second time. Furthermore it is unclear who is actually the provider and who is the customer. Is the provider the provider of the containers, or the provider of the goods? Is the

customer the one who orders the container, or the one who receives the container with the goods in it? If this is true, are there three delivering steps?

Claim Rejections - 35 USC § 101

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis for this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use or advance the technological arts.

In the present case, claims 1-14 only recite an abstract idea. The recited steps of merely receiving an order, ascertaining the number of containers, loading the goods, delivering the goods, monitoring the goods and retrieving the container, does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pen and paper. These steps only constitute an idea of how to ship and monitor temperature sensitive goods.

Additionally, for a claimed invention to be statutory, the claimed must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces containers that are used to ship temperature-sensitive goods, where the containers are reusable (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-14 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (6,539,189) in view of Retallick et al (6,189,330).

10. With respect to Claim 1: Murray discloses the following steps:

a. receiving order information for a shipping container (1st step in Figure 1),

b. ascertaining an appropriate number of containers (Column 4, lines 46-54),

c. loading goods into container (2nd Step in Figure 1),

d. determining alternate solutions (1st Step in Figure 1),

e. allowing customer to select alternate solution (1st Step in Figure 1),

f. implementing a shipping schedule (),

g. deliver goods to desired location (5th Step in Figure 1),

h. monitor delivery (3rd step in Figure 1),

i. maintain tracking data (7th Step in Figure 1),

j. unloading container (6th Step in Figure 1),

However, Murray fails to disclose delivering the containers to the customer before loading, retrieving and reusing the containers. Retallick discloses a reusable temperature sensitive container for delivering temperature sensitive goods (see abstract) that comprises the steps of:

k. providing the containers to the customer before loading (column 4, lines 5-12),

l. retrieving container after use and making it ready for future use (column 4, lines 14-24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the container of Murray to be delivered to the customer and to be

recycled according to Retallick, in order to reuse and refurbish the containers for future use. (See Retallick, columns 11 and 12).

11. With respect to Claims 2, 5 and 8: Murray discloses the delivering, tracking and monitoring is all done by the provider (see abstract and column 4, lines 19-25).

12. With respect to Claims 11 and 12: See Retallick, column 4, lines 18-24.

13. With respect to Claims 13 and 14: See Murray, Column 4, line 55 to Column 5, line 4.

14. With respect to Claims 3, 4, 6, 7, 9 and 10: Murray discloses the claimed invention, but he fails to specifically disclose the delivery, monitoring and tracking down by the customer or a 3rd party. At the time the invention was made it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the delivery, monitoring and tracking be down by either the customer or a 3rd party because Applicant has not disclosed that these being down by the customer or 3rd party provides any advantage or solves any stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the provider doing the delivering, monitoring and tracking because the steps of delivery, tracking and monitoring are still performed, they are just performed by a different entity, therefore would work equally as well.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ostro (6,445,976) discloses the use of a method of delivering refrigerated containers, Kadaba (6,539,360) discloses the use of tracking and shipping of special handling packages,

Bains et al. (6,625,584) disclose the se of a maritime freight shipping method, and Purdum (6,116,042), Yaddgo et al. (6,381,981), Malone et al. (6,531,974) and Derifield (5,924,302) discloses temperature sensitive shipping containers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamisue Webb

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600